



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/614,482	07/10/2000	Albert K. Chin	4589	1945

758 7590 07/02/2003

FENWICK & WEST LLP
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
----------	--------------

3731

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/614,482

Applicant(s)
Chin

Examiner
Michael Thaler

Art Unit
3731



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 28, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

Art Unit: 3731

The request for a continued prosecution application (CPA) under 37 CFR 1.53(d) filed on [1] is acknowledged. 37 CFR 1.53(d)(1) was amended to provide that the prior application of a CPA must be: (1) a utility or plant application that was filed under 35 U.S.C. 111(a) before May 29, 2000, (2) a design application, or (3) the national stage of an international application that was filed under 35 U.S.C. 363 before May 29, 2000. See *Changes to Application Examination and Provisional Application Practice*, interim rule, 65 Fed. Reg. 14865, 14872 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office 47, 52 (Apr. 11, 2000). Since a CPA of this application is not permitted under 37 CFR 1.53(d)(1), the improper request for a CPA is being treated as a request for continued examination of this application under 37 CFR 1.114. See *id.* at 14866, 1233 Off. Gaz. Pat. Office at 48. Applicant's submission filed on May 28, 2003 has been entered.

Claims 17-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 4.

Claims 1-6 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chin (5,916,233). Chin shows first lumen 25 for housing an endoscope 27 therein, transparent tip 13 and second lumen (one of the lumens described in col. 3, lines 29-32) having an open distal end 35 for housing a surgical instrument for

Art Unit: 3731

performing procedures on tissue viewed through the transparent tip 13. The Chin drawings fail to specifically show the open distal end 35 of second lumen positioned intermediate the proximal and distal ends of the first lumen. However, the open distal end 35 of second lumen is obviously positioned intermediate the proximal and distal ends of the first lumen since the transparent tip 13 extends significantly distally beyond the open distal end 35 of second lumen as seen in figures 2A, 3A-C and 4A-C. As to claims 2, 3, 5 and 15, the surgical instrument is not part of the claimed combination as indicated in claim 1, lines 9-10. As to claim 4, Chin fails to disclose the second lumen being keyed. However, it is well known in this art to key a lumen in order to insure that an instrument inserted therein is oriented at a specific direction. It would have been obvious to key the Chin second lumen so that it too would have this advantage. As to claim 11, Chin discloses a tissue bisector (e.g. the shears described in col. 4, lines 23-26). As to claim 14, Chin discloses retractor 17 (figure 2B). As to claim 16, Chin fails to disclose a storage groove. However, it is well known in this art to include a storage groove on a device in order to store an instrument inserted therein. It would have been obvious to include a storage groove on the Chin device so that it too would have this advantage.

Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chin (5,916,233) in view of Wilk et al.

Art Unit: 3731

(5,938,586). Chin fails to show a flexible hood coupled to the distal end of the second lumen. However, including a flexible hood on the distal end of the Chin second lumen in order to seal the end of the cannula and yet permit an instrument to pass therethrough would have been obvious since it is well known in this art to provide such a flexible hood for this reason. For example, Wilk shows flexible hood (602 or 608) on the distal end of an instrument lumen 604. Including a flexible hood on the distal end of the second lumen of Chin for this reason would have been obvious.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703)308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3590 for regular communications and (703)305-3590 for After Final communications.


Application/Control Number: 09/614,482

Page 5

Art Unit: 3731

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

mht
June 19, 2003



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731